

REMARKS

Claims 1, 3-7, 9-12, 14-18 and 20-29 are pending in this application. By this Amendment, claims 1, 12, 18 and 26 are amended. Support for amended claims 1, 12, 18 and 26 can be found, for example, on page 9, line 11 - page 10, line 12 in the present disclosure. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

Applicants appreciate the courtesies extended to Applicants' representative by Examiner Ghee in the January 29, 2004 telephone interview.

I. The Claims Define Patentable Subject Matter

The Office Action rejects claims 1, 6, 26 and 27 under 35 U.S.C. §102(e) as being anticipated by Savitzky et al. (hereinafter "Savitzky"), U.S. Patent No. 6,012,083. The rejection is respectfully traversed.

Applicants' claim 1 is directed to a method for submitting a document in electronic form to a service bureau for printing, including the steps of displaying plural printer routing options, one of the printer routing options being a service bureau for printing, receiving a print command input to the computer for printing at the service bureau a document stored in memory accessible to the computer, responsive to the print command, routing the document over Internet to both the service bureau or an intermediary for printing. The routing step further includes automatically activating a communications program in the computer upon selection of the print command, and transmitting the document to a server associated with the

service bureau or the intermediary. By this configuration, Applicants' invention allows a user to be within any application and send a print job to a service bureau with the same robustness and top level options as one would expect from a local or direct-networked printer.

However, it is respectfully submitted that Savitzky fails to disclose the steps of responsive to the print command, routing the document over Internet to both the service bureau or an intermediary for printing, and transmitting the document to a server associated with the service bureau or the intermediary, as recited in claim 1 and similarly recited in claim 26.

That is, Applicants' invention discloses routing the document over the Internet by optionally sending the print command to a service bureau or an intermediary for printing, whereas Savitzky only discloses a procedure for sending the document to the service bureau. In other words, Applicants' invention discloses an optional step for transmitting the document associated with the intermediary server. By having this configuration, it has significant advantages. For example, as described in page 9, lines 21-24 and Fig. 1, the intermediary may allow the user to select from more than one service bureau vendor (e.g., Kinko's and Ikon), and provide vendors with facilities to generate DVDs and CD ROMs.

Accordingly, Savitzky fails to disclose routing the document over Internet to both the service bureau or an intermediary for printing, and transmitting the document to a server associated with the service bureau or the intermediary, as recited in claim 1 and similarly recited in claim 26.

Further, Savitzky fails to disclose the step of displaying plural printer routing options, one of the printer routing options being a service bureau for printing, as recited in claim 1, and similarly recited in claims 12, 18 and 26.

The Office Action alleges that Savitzky discloses a method for "displaying (showing) plural printer routing options (printer locations read on plural printer routing options), one of the printer routing options (printer locations) being a service bureau (printer agency 60 reads on service bureau) for printing (col. 13, lines 15-28)". Although Savitzky discloses that the printer agency 60 may select a printer by presenting the user with a web page showing printer locations (col. 13, lines 25-28), it is respectfully submitted that Savitzky does not explicitly disclose that one of the printer routing options is a service bureau. In other words, Savitzky discloses that the user selects a printer by merely showing the printer locations, whereas Applicants' claimed invention discloses that one of the printer routing options is a service bureau for printing.

Because Savitzky fails to disclose each and every feature of the claimed invention, it cannot provide a basis for rejection under 35 U.S.C. §102. Thus, reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action rejects claims 23 and 29 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara, U.S. Patent Publication No. US 2003/0011806 A1; rejects claims 3, 5, 7 and 10 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara, and further in view of Tonkin, U.S. Patent No. 6,134,568; rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara in view of Tonkin, and further in view of Cheng et al. (hereinafter "Cheng"), U.S. Patent No. 6,012,070; rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Cheng; rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Bellucco et al. (hereinafter "Bellucco"), U.S. Patent No. 5,524,085; rejects claims 12, 15-18, 21-22 and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara, and further in view of Savitzky; rejects

claims 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and Savitzky, and further in view of Bellucco; and rejects claim 28 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Tonkin. The rejections are respectfully traversed.

As discussed above, Savitzky neither discloses nor suggests Applicants' claimed invention as found in claims 1 and 26, the independent claims from which rejected claims 3-7, 9-11 and 27-29 depend from. Claims 12, 14-18, 20-22, 24-25 also fails to similarly disclose or suggest routing the document over Internet to both the service bureau or an intermediary for printing. Accordingly, Shiohara, Tonkin, Cheng and Bellucco fail to overcome the noted deficiency of Savitzky. Thus, it is respectfully requested that the rejections be withdrawn.

For at least these reasons, Savitzky, Shiohara, Tonkin, Cheng and Bellucco, either alone or in combination, fail to disclose, teach or even suggest all of the features recited in claims 1, 3-7, 9-12, 14-18 and 20-29. Thus, the various asserted combination of Savitzky, Shiohara, Tonkin, Cheng and Bellucco, fail to disclose or render obvious the subject matter of claims 1, 3-7, 9-12, 14-18 and 20-29. Withdrawal of the rejections of claims 1, 3-7, 9-12, 14-18 and 20-29 based on Savitzky, Shiohara, Tonkin, Cheng and Bellucco and the various asserted combination of these references are respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

David J. Cho
Registration No. 48,078

JAO:DJC/brc

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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